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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,823	09/18/2001	Edward L. Beery II	EBP001US	8192
43581 7590 03/03/2010 CAVEN & AGHEVLI LLC 9249 S. BROADWAY BLVD UNIT 200-201 HIGHLANDS RANCH, CO 80129			EXAMINER NGUYEN, TRI V	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			03/03/2010 PAPER	

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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8 *Ex parte* EDWARD L. BEERY II  
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11 Appeal 2009-014842  
12 Application 09/954,823  
13 Technology Center 1700  
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16 Decided: March 3, 2010  
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19 Before HUBERT C. LORIN, ANTON W. FETTING, and  
20 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.  
21 FETTING, *Administrative Patent Judge*.

22  
DECISION ON APPEAL

## STATEMENT OF THE CASE

Edward L. Beery II (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 9-28, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION<sup>1</sup>

**We AFFIRM.**

## THE INVENTION

The Appellant invented a type of promotional marketing effort aimed at specific consumers based on real-time, consumer entered, planned purchase information. The consumer actively selects the promotions that are of interest, the selected promotions are electronically stored and the promotions are either printed on the consumer's printer or electronically retrieved. (Specification 1: Field of Invention).

An understanding of the invention can be derived from a reading of exemplary claim 9, which is reproduced below [bracketed matter and some paragraphing added].

<sup>1</sup> Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed January 12, 2007) and Reply Brief ("Reply Br.," filed July 17, 2009), and the Examiner's Answer ("Ans.," mailed May 19, 2009).

9. A computer-based method for presenting one or more promotions, comprising:

- [1] receiving,
  - in a computing system,
  - a signal
  - identifying a first product associated with an order;
- [2] associating
  - a first product identifier with the first product;
- [3] presenting,
  - via a user interface,
  - one or more promotions
  - when one or more promotions for at least a second product are associated with the first product identifier.

## THE REJECTIONS

The Examiner relies upon the following prior art:

Katz                      US 6,055,513                      Apr. 25, 2000

Claims 9-23, 25, 26, and 28 stand rejected under 35 U.S.C. § 102(b) as anticipated by Katz.

Claims 24 and 27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Katz.

## ISSUES

The Appellant argues several sets of claims, so the claim by claim issues are taken up in the Analysis *infra*. The issue of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims

9-23, 25, 26, and 28 under 35 U.S.C. § 102(b) as anticipated by Katz turns on whether Katz describes the limitations in the claims.

The issue of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 24 and 27 under 35 U.S.C. § 103(a) as unpatentable over Katz turns on whether it was predictable to modify Katz to describe the limitations in the claims.

#### FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

##### *Facts Related to the Prior Art*

##### *Katz*

01. Katz is directed to effecting commercial transactions at remote locations over communication networks, especially telephonic and electronic commerce transactions. More specifically, using telemarketing and electronic commerce systems, and especially the intelligent product and service selection for proffer to a customer, Katz describes the selection and offering of an upsell transaction, where the product or service offered differs materially from the product or service for which the contact was made. Katz 1:8-17.

02. The term "upsell" means an offer or provision of a good or service which is selected for offer to the customer and differs from the good or service for which the primary contact was made. Katz 13:38-41.

03. In a typical telemarketing application, the item for which the caller makes initial contact is the item which is ordered by the customer. In certain instances, attempts are made to sell other goods or services directly related to the product for which contact was made. Katz 1:43-47.

04. In one implementation of the invention, the system and methods obtain input information for the system from a primary transaction, identify one or more goods or services for possible proffer and upsell to the customer based at least in part upon the primary transaction data information provided to the system, and thereafter, offer the user or customer one or more items determined to be among the optimum upsells. Katz 8:38-45. This requires obtaining primary transaction data with respect to the transaction. Katz 8:53-55. This primary transaction data is an input for determining the upsell. Katz 8:64-65.

05. The primary transaction may be a purchase of a product, which may be consummated. Katz 9:8-11.

06. Upon receipt of indication that the primary transaction is to be consummated, the system may so designate the product. Katz 11:59-60.

07. A telemarketing operator may take the order entry data for the primary transaction. Upon completion of the primary transaction, order data is compared to one or more databases for analysis. Katz 13:58-64.

- 1            08. Upon generating the potential upsells, that information is  
2            provided to the system for presentation to the operator. Multiple  
3            options may be presented for selection by the operator. Katz  
4            18:27-32.
- 5            09. The primary transaction order data is entered into Katz's  
6            system. Katz 19:24-27.
- 7            10. If the upsell serves to obviate the purpose for the primary  
8            transaction, such as when the primary transaction is for customer  
9            service or repair, and the upsell is successful in providing the  
10           customer with a new product in replacement thereof, then the  
11           primary transaction is not consummated. Katz 19:32-37.
- 12           11. The primary transaction may be completed, such as through  
13           consummation of a sale, or it may not be if another product is  
14           substituted. Katz 22:32-45.
- 15           12. Katz uses a multiple input, dynamic, preferably real-time search  
16           system to identify the items for potential upsell from the various  
17           inputs. Katz 22:62 – 63:3.
- 18           13. The system may use prior purchases in determining the upsell  
19           for offer, for example seeing whether a customer previously called  
20           to buy product X, and was successfully upsold product Y. Katz  
21           24:7-20.
- 22           14. Katz's system includes product information which is provided  
23           to a customer. Katz 25:13-16.
- 24           15. Katz's claim 1 reads as follows:

1           1. A method for providing offers in real time of an item  
2           constituting a good or a service in the form of offers for  
3           purchase of the item to prospective customers as users of  
4           the system, utilizing an electronic communications  
5           device, comprising the steps of:  
6           establishing a communication via the electronic  
7           communications device between the user and the system  
8           for purpose of a user initiated primary transaction for  
9           purchase of a specific good or service,  
10          obtaining primary transaction data with respect to the  
11          primary transaction, including the identity of the  
12          prospective customer and of the good or service for  
13          purchase in the primary transaction,  
14          generating an upsell offer as a result of the user initiated  
15          primary transaction by:  
16          utilizing the identity of the prospective customer to  
17          obtain at least a second data element relating to the user,  
18          utilizing at least in part the primary transaction data  
19          including the identity of the good or service of the  
20          primary transaction and the second data element and  
21          determining at least one item for a prospective upsell  
22          transaction with the prospective customer, and  
23          offering the item to the prospective customer and  
24          receiving an acceptance of the offer from at least one  
25          user in real time during the course of the user initiated  
26          communication.

27          *Facts Related To Knowledge of Ordinary Skill in the Art*

28          16. One of ordinary skill in the art of online purchasing systems  
29          knew that it was required that all items offered for sale have  
30          descriptions and product identifiers in the database of such  
31          products for the sale transaction to index product information and  
32          identify the contents of the sale.



PRINCIPLES OF LAW

*Anticipation*

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

*Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." *Graham*, 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. "The combination of familiar elements according to known

methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416.

### ANALYSIS

#### *Independent claims 9, 17, 23, and 26*

The Appellant argues that none of the limitations are described by Katz. Appeal Br. 7-13 and 20-23. We disagree. The Appellant’s argument appears to take issue with the broad swath of Katz referred to by the Examiner by inviting a more detailed and particular analysis. Appeal Br. 13 and 22. We will therefore detail more precisely for the benefit of the Appellant where the limitations are described.

Limitations [1] and [2] require receiving a signal identifying a product associated with an order in a computing system and associating a first product identifier with the that product. In Katz’s system a signal identifying a product is initially made by a customer. FF 01, FF 09. This product is associated with the customer’s primary purchase transaction, in other words purchase order. FF 03, FF 10. Katz’s system may also rely on products identified in prior purchase orders. FF 12. Katz’s system includes product information which is provided to a customer. FF 14. Such information would necessarily include an identifier to properly index and identify the products. FF 16. Katz’s claim 1 explicitly recites obtaining the identity of the product a customer wants to purchase. FF 15. Thus, Katz describes limitations [1] and [2].

Limitation [3] requires presenting promotions associated with first product identifier on a user interface. Katz describes using the primary

transaction data as input to a query for identifying goods for upsell.<sup>2</sup> FF 04.  
The primary transaction data necessarily includes the product identifier in a  
purchase transaction, given that the products purchased form the subject of  
the transaction. Katz's claim 1 also explicitly recites using the product  
identifier to identify an upsell offer. FF 15. An upsell offer is a promotion  
since it is an offer that is being promoted by the seller. These offers are  
presented on a user interface to the seller. FF 08.

Thus, Katz describes all the limitations of independent claim 9. Claims  
17, 23, and 26 are for essentially the same limitations and Katz describes  
those limitations accordingly.

*Dependent claims 10 and 18*

Dependent claims 10 and 18 require determining, based on the first  
product identifier, whether one or more promotions for at least a second  
product are associated with the first product identifier. The Appellant argues  
that Katz fails to describe this. Appeal Br. 14-17. We disagree.

Katz's system includes product information which is provided to a  
customer. FF 14. Such information would necessarily include an identifier  
to properly index and identify the products. FF 16. Katz's claim 1 explicitly  
recites obtaining the identity of the product a customer wants to purchase.  
FF 15. Katz describes using the primary transaction data as input to a query  
for identifying goods for upsell. FF 04. The primary transaction data  
necessarily includes the product identifier in a purchase transaction, given

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<sup>2</sup> The term "upsell" means an offer or provision of a good or service which is  
selected for offer to the customer and differs from the good or service for  
which the primary contact was made. FF 02.

that the products purchased form the subject of the transaction. Katz's claim 1 also explicitly recites using the product identifier to identify an upsell offer. FF 15. An upsell offer is a promotion since it is an offer that is being promoted by the seller. These offers are presented on a user interface to the seller. FF 08. Thus, Katz describes determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier.

*Dependent claims 11 and 19*

Dependent claims 11 and 19 require comparing the first product identifier with a list of product identifiers associated with promotional offers. The Appellant argues that Katz fails to describe this. Appeal Br. 17-18. We disagree. Katz describes using the primary transaction data as input to a query for identifying goods for upsell. FF 04. The primary transaction data necessarily includes the product identifier in a purchase transaction. Katz uses a multiple input, dynamic, preferably real-time search system to identify the items for potential upsell from the various inputs. FF 12. Katz's claim 1 describes comparing the first product identifier with a list of product identifiers associated with promotional offers. FF 15. Thus, Katz describes comparing the first product identifier with a list of product identifiers associated with promotional offers.

*Dependent claim 12*

Dependent claim 12 requires the promotion be associated with a combination of one or more product identifiers. The Appellant argues that Katz fails to describe this. Appeal Br. 18-19. We disagree. Katz uses a multiple input, dynamic, preferably real-time search system to identify the

plural items for potential upsell from the various inputs. FF 12. Katz's claim 1 describes comparing the first product identifier with a list of plural product identifiers associated with promotional offers. FF 15. To the extent the Appellant is arguing the absence of the specific phrase "product identifier" in Katz, Katz uses the equivalent phrase "identity of the good or service." FF 15. Thus, Katz describes the promotion be associated with a combination of one or more product identifiers.

*Dependent claims 13 and 20*

Dependent claims 13 and 20 require presenting one or more replacement products in the user interface. The Appellant argues that Katz fails to describe this. Appeal Br. 19-20. We disagree. Katz describes the upsell having been for replacements. FF 10. Thus, Katz describes presenting one or more replacement products in the user interface.

*Dependent claims 24 and 27*

Dependent claims 24 and 27 require associating the first product identifier with one or more promotional codes. These claims were rejected as obvious over Katz. Ans. 6. The Appellant argues that Katz fails to describe this. Appeal Br. 25. We disagree. As we found above, Katz describes associating the first product identifier with one or more promotions. This is particularly so in Katz's claim 1. FF 15. The Examiner found it was notoriously well known and therefore predictable to identify promotions with identifiers. Ans. 6. The Appellant argues that no evidence for this is presented. Appeal Br. 25.

This argument does not rebut the Examiner's findings as to predictability of a notoriously well known technique. More to the point, in database

1 systems such as in Katz, some form of index is necessary to retrieve data.  
2 So some index is necessary to retrieve Katz's promotional information.  
3 Such an index identifies the associated promotions. Thus, it was not only  
4 predictable, but necessary and therefore inherent to associate Katz's first  
5 product identifier with one or more promotional codes.

6 The Appellant presents no separate arguments in support of patentability  
7 for claims 14-16, 21, 22, 25, and 28. Thus the rejections of these claims  
8 stand for the same reasons as their parent claims 9, 17, 23, and 26.

#### 9 CONCLUSIONS OF LAW

10 The Appellant has not sustained its burden of showing that the Examiner  
11 erred in rejecting claims 9-23, 25, 26, and 28 under 35 U.S.C. § 102(b) as  
12 anticipated by Katz.

13 The Appellant has not sustained its burden of showing that the Examiner  
14 erred in rejecting claims 24 and 27 under 35 U.S.C. § 103(a) as unpatentable  
15 over Katz.

#### 16 DECISION

17 To summarize, our decision is as follows.

- 18 • The rejection of claims 9-23, 25, 26, and 28 under 35 U.S.C. § 102(b)  
19 as anticipated by Katz is sustained.
- 20 • The rejection of claims 24 and 27 under 35 U.S.C. § 103(a) as  
21 unpatentable over Katz is sustained.

22 No time period for taking any subsequent action in connection with this  
23 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED

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6 mev

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